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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,131	09/16/2003	Jesse D. Crum	WK/2003-05/US	3994

7590 09/09/2005  
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EXAMINER
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DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/663,131		CRUM, JESSE D.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Tamra L. Dicus		1774	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 16-19 and 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08-02-04</u> . | 6) <input type="checkbox"/> Other: ____.  |

*u*

**DETAILED ACTION**

Acknowledge is made of the submitted IDS.

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15, 20-28 drawn to a business form, classified in class 428, subclass 195.1.
  - II. Claims 16-19 and 29-32, drawn to a method of communicating the benefits of a business form assembly classified in class 283, subclass 106.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(i)). Further the business form of I is distinct from II as the form can be used without selling and distributing.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mike Maier on 08/30/05 a provisional election was made with traverse to prosecute the invention of I, claims 1-15, 20-28 . Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-19 and 29-32,

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

Claims 2-3 and 5 contain improper Markush grouping. The language {"wherein the X is selected from"} is not an acceptable Markush group listing. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). Suitable language to include would be {"wherein the X are selected from the group consisting of". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, 10 and 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 and 26-27 recite the limitations "said property" and "said material", there are more than one material and property present, thus it is confusing as to which property "said property" and which material "said material" refers.

Claim 4 is not clear due to the limitation, "first and second properties are composition".

Claim 10 is not clear due to the limitation, "first and substrates has at least one pattern".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 6,340,512 to Mercer et al.

Mercer teaches a business form (10, FIG. 1) with removable, joined, and adjacent integrated cards/labels of paper or cardstock (18 and 20, FIG. 1 and associated text, first and second removable substrates having a property), having a plurality of patterns spaced apart (tape patches 28, 50, and 26, FIG. 1 and associated text) that connects and adjoins two said removable substrates. The patterns are composed of segmented strips comprised of adhesive tape, resinous material, or cellophane (col. 3, line 14-15, col. 3, line 28-30). Claims 1-6, 10 and 13-14 (see also col. 4, lines 5-30, col. 2, lines 65-68) are met.

Claim 7 is met as the Figures show a substantially square shape, and that it has a square shape when placed in a stack naturally occurs is suggestive and does not limit the claim.

Regarding claim 10, at least one pattern is disposed on the first substrate (indicia printed on 18 and 20, FIG. 2 and associated text).

Claim 11, the strips may be provided with indicia (col. 4, lines 20-23).

Claim 12, the surface affinity effect is inherent as the same materials and structure is provided.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al. in view of USPN 4,627,994 to Welsch.

Mercer essentially teaches the claimed invention.

While Mercer teaches removable labels and having a form in continuous roll form or stack arrangement (col. 3, line 65-col. 4, line 5), Mercer does not explicitly teach the removable card labels are self-laminating.

Welsch teaches a continuous business form including self-laminating labels (pressure sensitive adhesive) (48, FIG. 2 and associated text), which construction aids in adhering of the label preventing wrinkling while in a folded stack or roll form of continuous sheets.

It would have been obvious to one having ordinary skill in the art to have modified the form of Mercer to employ self-laminating labels because Welsch teaches the labels may be removed by peeling from the form and aids in adhering of the label preventing wrinkling while in a folded stack or roll form of continuous sheets (Abstract, FIG. 1-2, col. 2, lines 5-55, col. 3, lines 1-20, col. 3, lines 65-68, and col. 4, lines 60-68). The combination of prior art thus produces the instant invention as claimed.

Claims 20 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al.

Mercer teaches removable labels and having a form in continuous roll form or fan-folding arrangement (col. 3, line 65-col. 4, line 5). Further, Mercer teaches a business form (10, FIG. 1) with removable, joined, and adjacent integrated cards/labels of paper or cardstock (18 and 20, FIG. 1 and associated text, first and second removable substrates having a property), having a plurality of patterns spaced apart (tape patches 28, 50, and 26, FIG. 1 and associated text) that connects and adjoins two said removable substrates. The patterns are composed of segmented strips comprised of adhesive tape, resinous material or cellophane (col. 3, line 14-15, col. 3, line 28-30). Claims 20 and 23 (see also col. 4, lines 5-30, col. 2, lines 65-68) are met.

To claim 22, at least one pattern is disposed on the first substrate (indicia printed on 18 and 20, FIG. 2 and associated text) and the strips may be provided with indicia (col. 4, lines 20-23).

Further to claim 20, Mercer does not explicitly define the thicknesses of the label and form, however, it would have been obvious to one having ordinary skill in the art to have different thicknesses because Mercer teaches the card label is of paper, cardstock or plastic cut into any shape or size (col.2, lines 65-68) and teaches it is the card and form thickness is an optimizable feature so as to avoid unnecessary bulk (col. 1, lines 50-68). It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Thickness effects the way the continuous forms feed through the printer. The combination of prior art thus produces the instant invention as claimed.

Claims 24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al. in view of USPN 4,627,994 to Welsch.

Mercer teaches removable labels and having a form in continuous roll form or

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fan-folding arrangement (col. 3, line 65-col. 4, line 5). Further, Mercer teaches a business form (10, FIG. 1) with removable, joined, and adjacent integrated cards/labels of paper or cardstock (18 and 20, FIG. 1 and associated text, first and second removable portions), having a plurality of patterns spaced apart (tape patches 28, 50, and 26, FIG. 1 and associated text) that connects and adjoins two said removable portions. The patterns are composed of segmented strips comprised of adhesive tape, resinous material or cellophane (col. 3, line 14-15, col. 3, line 28-30). At least one pattern is disposed on the first substrate (indicia printed on 18 and 20, FIG. 2 and associated text) and the strips may be provided with indicia (col. 4, lines 20-23). Claims 24, 28, and 26 are met (see also col. 4, lines 5-30, col. 2, lines 65-68).

To claim 27, the surface affinity effect is inherent as the same materials and structure is provided.

Further to claim 24, Mercer does not explicitly define the thicknesses of the label and form as different, however, it would have been obvious to one having ordinary skill in the art to have different thicknesses because Mercer teaches the card label is of paper, cardstock or plastic cut into any shape or size (col.2, lines 65-68) and teaches it is the card and form thickness is an optimizable feature so as to avoid unnecessary bulk (col. 1, lines 50-68). It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Thickness effects the way the continuous forms feed through the printer.

Further to claim 24, Mercer does not explicitly define the form as a stack, while stating the form is in roll or fan-folding form.



Welsch teaches a continuous business form including self-laminating labels (pressure sensitive adhesive) (48, FIG. 2 and associated text), which construction aids in adhering of the label preventing wrinkling while in a folded stack or roll form of continuous sheets.

It would have been obvious to one having ordinary skill in the art to have modified the form of Mercer to employ a stack consisting of 10 to 10,000 assemblies because Welsch teaches a folded stack or roll form of continuous sheets are equivalents and may contain a variety of individual forms as illustrated (Abstract, FIG. 1, col. 2, lines 5-55, col. 3, lines 1-20, col. 3, lines 65-68, and col. 4, lines 60-68).

Claims 8-9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al. in view of USPN 6,830,795 to Downs.

Mercer essentially teaches the claimed invention as applied to claims 1 and 20 above.

Mercer does not expressly teach a business form having the pattern stripes selected from wax or silicone coatings (claims 8 and 21) or having a roughened surface (claim 9).

Downs teaches labels used in various carriers such as envelopes and parcels for identification a multilayered adhesive stripes (126, 130, 134, FIG. 1-4) having a coating of wax or silicone (106, 114, 120, FIG. 1-4) on top to aid in easy release when labels are in a stack and a plurality of labels are used in a roll or stack (FIG. 1 and 2). See further col. 1, lines 5-10 and col. 4, lines 20-35.

It would have been obvious to one having ordinary skill in the art to have included wax or silicone to the stripes of Mercer because Downs teaches multilayered adhesive stripes having a coating of wax or silicone on top to aid in easy release when a plurality of labels are in a stack or used in a roll or stack (FIG. 1-4 and col. 4, lines 20-35 of Downs). That the stripes have a

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roughened surface would be expected because the same material, pattern, and indicia print are applied to the stripes as taught by the prior art.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al. in view of USPN 4,627,994 to Welsch and further in view of USPN 6,830,795 to Downs.

Mercer and Welsch essentially teach the claimed invention as applied to claim 24 above.

Mercer does not expressly teach a business form having the pattern stripes selected from wax or silicone coatings (claim 24).

Downs teaches labels used in various carriers such as envelopes and parcels for identification a multilayered adhesive stripes (126, 130, 134, FIG. 1-4) having a coating of wax or silicone (106, 114, 120, FIG. 1-4) on top to aid in easy release when labels are in a stack and a plurality of labels are used in a roll or stack (FIG. 1 and 2). See further col. 1, lines 5-10 and col. 4, lines 20-35.

It would have been obvious to one having ordinary skill in the art to have included wax or silicone to the stripes of Mercer and to modify the combination of Mercer and Welsch because Downs teaches multilayered adhesive stripes having a coating of wax or silicone on top to aid in easy release when a plurality of labels are in a stack or used in a roll or stack (FIG. 1-4 and col. 4, lines 20-35 of Downs).

### *References of Interest*

The remaining references listed on form(s) 892 and/or 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

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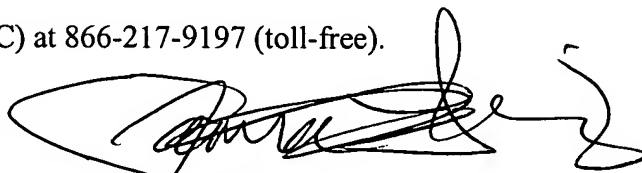
- USPN 6,309,725 to Peterson et al. Peterson teaches a business form (10, FIG. 1) with adjacent integrated cards/labels of paper or cardstock (both 52s, FIG. 1 and associated text, first and second substrates having a property), having a plurality of patterns spaced apart (tape patches 41, 42, 39, and 40, FIG. 1 and associated text).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

August 31, 2005



RENA DYE  
SUPERVISORY PATENT EXAMINER

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